

REMARKS/ARGUMENTS

I. General Remarks and Disposition of the Claims.

The application has been reviewed in light of the Final Office Action mailed May 22, 2006. At the time of the Final Office Action, claims 1-38 were pending in this application. Claims 1-38 have been rejected. Claims 1, 29, and 32 have been amended.

All amendments are made in a good faith effort to advance the prosecution on the merits of this case and are supported by the specification as filed. Please consider the application in view of the following remarks. Applicants thank Examiner for his careful consideration of this application.

II. Remarks Regarding Claim Objections.

Claim 1 has been objected to because "as currently worded, line 3 makes it appear as though the preconfigured division does not occur until disposal occurs." (Final Office Action at 2.) The Examiner suggests "replacing 'at' with --for-- in between 'element' and 'disposal'" to clarify the claim. (Final Office Action at 2.) Applicants have amended claim 1 to correct this informality, and respectfully request the withdrawal of this objection.

III. Remarks Regarding Rejection of Claims Under 35 U.S.C. § 102

A. Claims 1-4, 7-9, 13-21, 23, 26, 27, 29-35, 37, and 38 Are Not Anticipated by *Loomis*.

Claims 1-4, 7-9, 13-21, 23, 26, 27, 29-35, 37, and 38 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,780,294 issued to Loomis (hereinafter "*Loomis*"). Applicants respectfully traverse. *Loomis* does not disclose, expressly or inherently, every element recited in the subject claims as required to anticipate the claims under 35 U.S.C. § 102(b). MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004) (hereinafter "MPEP").

In particular, independent claims 1, 29, and 32, as amended, recite the inclusion of a segmented slip as well as a compression element preconfigured for segmentation in downhole tool. Nowhere does *Loomis* disclose or suggest such a configuration. Rather than disclosing a disposable downhole tool comprising *both* a slip and a compression element, both preconfigured for segmentation, *Loomis* is directed to a downhole tool only comprising a compression element preconfigured for segmentation. (*Loomis*, Figs. 1 and 3) Accordingly, *Loomis* does not disclose or suggest a downhole tool comprising a slip *and* a compression element preconfigured for segmentation, and thus does not disclose or suggest each and every element of independent claims 1, 29, and 32.

Therefore, independent claims 1, 29, and 32, as amended, are not anticipated by *Loomis*. The remaining rejected claims depend either directly or indirectly on independent claims 1, 29, and 32. All these dependent claims, which include all the limitations of their corresponding independent claim, are allowable for at least the reasons cited above with respect to independent claims 1, 29, and 32. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 1-4, 7-9, 13-21, 23, 26, 27, 29-35, 37, and 38.

B. Claims 1-4, 7-21, 23, 24, 25, 27, 29, and 31-37 Are Not Anticipated by *Thornton*.

Claims 1-4, 7-21, 23, 24, 25, 27, 29, and 31-37 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,350,016 issued to Thornton, Jr. (hereinafter "*Thornton*"). Applicants respectfully traverse.

As to claims 1, 29, and 32, as amended, *Thornton* does not disclose a downhole tool comprising a segmented slip *and* a segmented compression element, as required by the independent claims. Nowhere does *Thornton* disclose or suggest such a configuration. Rather than disclosing a disposable downhole tool comprising *both* a segmented slip and a compression

element preconfigured for segmentation, *Thornton* is directed only to a segmented slip. Accordingly, *Thornton* does not disclose or suggest a downhole tool comprising a slip *and* a compression element, both preconfigured for segmentation, and thus does not disclose or suggest every element of independent claims 1, 29, and 32.

Furthermore, as to claims 1 and 29, Applicants maintain that *Thornton* describes a segmented slip, not a tool. A slip is used to suspend and does not have a “compression element” as the Examiner indicates. (Final Office Action at 9.) As indicated in Applicants’ specification, a slip 26 may be included, along with a sealing element 32, in a well plug 12. However, the slip 26 is not analogous to the compression element 50 or the sealing element 32. Additionally, the segmented slip of *Thornton* is fragmented before it is used, so that it can move laterally “while maintaining the slip segment’s slidable engagement with the tool.” (*Thornton*, Column 2, lines 2-3) In other words, the slip breaks into a plurality of slip parts in order to bite into a pipe to hold a tool (such as a bridge plug) in place at that particular location. (*Thornton*, Column 3, lines 10-12)

Thornton further indicates that it is undesirable for the slip parts (18) to fall to the bottom of the wellbore. (*Thornton*, Column 3, lines 39-49) Specifically, *Thornton* states “all slidable engagement of slip parts 18 through 20 with tool 4 is lost and unrestrained parts 18 through 10 become useless debris at the bottom of the wellbore rather than serving as an integral part of the bridge plug 4.” (*Thornton*, Column 3, lines 50-54) In the instant claims, on the other hand, the tool is disposable, and it is desirable that the segmenting event results in the compression element being released. This is the opposite of the breaking of the slip (8) into slip parts (18), which results in engagement, as indicated in *Thornton*.

As to claim 32, for analogous reasons to those stated above, the segmenting of *Thornton* does not “aid in the disposal of the downhole tool.”

Therefore, independent claims 1, 29, and 32, as amended, are not anticipated by *Thornton*. The remaining rejected claims depend either directly or indirectly on independent claims 1, 29, and 32. All these dependent claims, which include all the limitations of their corresponding independent claim, are allowable for at least the reasons cited above with respect to independent claims 1, 29, and 32. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 1-4, 7-21, 23, 24, 25, 27, 29, and 31-37.

C. Claims 1, 2, and 22 Are Not Anticipated by *Hushbeck*.

Claims 1, 2, and 22 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,701,959 issued to Hushbeck et al. (hereinafter "*Hushbeck*"). Applicants respectfully traverse.

As to claim 1, as amended, *Hushbeck* does not disclose a downhole tool comprising a segmented slip *and* a segmented compression element, as required by the independent claim. The Examiner states that Hushbeck comprises "a compression element" because "the shoe 150 is still subject to compression since the elements above and below the shoe are pressed against it during actuation of the tool." (Final Office Action at 9.) However, *Hushbeck* does not disclose or suggest a downhole tool comprising a slip *and* a compression element, both preconfigured for segmentation, and thus does not disclose or suggest every element of independent claim 1.

Accordingly, independent claim 1, and corresponding claims 2 and 22 depending therefrom, are patentable over *Hushbeck* for at least the reasons stated above. Therefore, Applicants request that Examiner withdraw his rejection of these claims and allow them to issue.

D. Remarks Regarding 35 U.S.C. 102(e) Rejections Under *Schwendemann*.

Claims 1-9, 13, 16, 24-26, 28-30, 32-35, 37, and 38 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2003/0213601 to *Schwendemann* et al. (hereinafter “*Schwendemann*”).

Applicants respectfully traverse the rejection of claims 1-9, 13, 16, 24-26, 29-30, 32-35, 37, and 38. As to claims 1, 29, and 32, as amended, *Schwendemann* does not disclose a downhole tool comprising a segmented slip *and* a segmented compression element as required by the independent claims. Nowhere does *Schwendemann* disclose or suggest such a configuration. Rather than disclosing a disposable downhole tool comprising *both* a segmented slip and a compression element preconfigured for segmentation, *Schwendemann* is directed to a seal assembly comprising a seal element. (*Schwendemann*, Abstract) Accordingly, *Schwendemann* does not disclose or suggest a downhole tool comprising a slip *and* a compression element, both preconfigured for segmentation, and thus does not disclose or suggest every element of independent claims 1, 29, and 32.

Accordingly, independent claims 1, 29, and 32, and corresponding claims 2-9, 13, 16, 24-26, 30, 33-35, 37, and 38 depending therefrom, are patentable over *Schwendemann* for at least the reasons stated above. Therefore, Applicants request that Examiner withdraw his rejection of these claims and allow them to issue.

As to claim 28, in order to form a basis for a § 102(e) rejection, the earlier patent or patent application must be “by another.” See 35 U.S.C. § 102(e). Submitted herewith is a declaration under 35 U.S.C. § 1.132 showing that the relevant disclosure in the *Schwendemann* Application is Applicant’s own work, and thus the invention disclosed therein is not by “another.” See MPEP § 716.10 (2004). Accordingly, Applicants respectfully submit that the 35

U.S.C. § 102(e) rejection of claim 28 based on *Schwendemann* has been overcome, and respectfully request the withdrawal of this rejection.

IV. Remarks Regarding Rejection of Claims Under 35 U.S.C. § 103 -- Claims 10-12 and 36 Are Not Anticipated by *Loomis*.

Claims 10-12, and 36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Loomis*. Applicants respectfully traverse.

As stated above, *Loomis* does not teach a downhole tool comprising *both* a segmented slip and a segmented compression element. Thus, even if *Loomis* teaches releasing the downhole tool, it does not teach a downhole tool comprising both a segmented slip and a segmented compression element.

Furthermore, as to claims 10 and 36, Applicants maintain the argument that the segmenting of *Loomis* would not be obvious in connection with releasing the downhole tool. Since setting necessarily occurs before releasing the tool, it would be senseless to segment (and thus set) a tool upon release. As to claim 12, it would also be counterproductive for the segmenting of *Loomis* to take place in connection with the destruction of a substantial structural part. Applicants can find no logical reason to destroy a substantial structural part in order to set the tool.

Furthermore, Examiner made the following statement on page 8 of the Office Action dated November 28, 2005, and page 8 of the Final Office Action:

[I]t would have been obvious to one of ordinary skill in the art that, if the packing 18 were to be placed in an area downhole where the inner diameter of the casing became too large . . . then, upon actuation of the device, the rings 26 would become overstressed and be destroyed. Thereafter, the segments 24 would simply go past the edge of packer head 16 and either fall into the wellbore, or become caught up in the production/drilling fluids. Evidence of such events can be seen in Figures 1-4 of US patent 5,350,016.

Even if overextension of the device of *Loomis* may cause the device to be destroyed, this destruction is undesirable, and one of ordinary skill in the art would seek to avoid this outcome. Overextension would prevent the device from setting, its intended function. That is, the device would be destroyed before it was ever used. This would make the insertion of the device into the wellbore an entirely pointless endeavor, as the device would have no utility whatsoever. This position is supported by the statement in *Thornton* that “all slidable engagement of slip parts 18 through 20 with tool 4 is lost and *unrestrained parts . . . become useless debris at the bottom of the wellbore rather than serving as an integral part of the bridge plug 4.*” (*Thornton*, Column 3, lines 50-54) (emphasis added). Therefore, the instant claims were not obvious in light of *Loomis* at the time of invention.

Accordingly, dependent claims 10-12, and 36 are patentable over *Loomis* for at least the reasons stated above. Therefore, Applicants request that Examiner withdraw his rejection of these claims and allow them to issue.

V. No Waiver.

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

SUMMARY

In light of the above amendments and remarks, Applicants respectfully submit that the application is now in condition for allowance and earnestly solicit early notice of the same. Should Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, Examiner is invited to contact the attorney of record by telephone, facsimile or electronic mail, as indicated below.

Applicants have included the appropriate fee of \$790.00 for the enclosed RCE under 37 C.F.R. § 1.17(e). Applicants believe that there are no additional fees due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for any extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition therefore, and direct that any fees be debited from Baker Botts L.L.P., Deposit Account No. 02-0383, Order Number 063718.0158.

Respectfully submitted,

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